

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Erroneously Issued Office Action During 3-Month Suspension of Action

Applicants requested a 3-month suspension of action when the Request for Continued Examination was filed on March 13, 2009. Despite this request, the Examiner erroneously issued a Final Office Action on May 26, 2009. As such, Applicants respectfully request that the Final Office Action of May 26, 2009 be vacated.

In view of this, Applicants respectfully submit this Amendment in response to the Office Action dated September 15, 2008 prior to the expiration of the 3-month suspension of action.

Moreover, should the instant reply during the earlier requested 3-month period of suspension of action not result in an allowance of the pending claims, the Examiner is earnestly solicited to ensure that any next issued Office Action is NON-FINAL, based on the new issues raised by the instant reply and enclosed 37 CFR § 1.132 Declaration of Mr. Tomoki Kawakita being submitted herewith.

Status of the Claims

Claims 1-5 remain pending in the above-identified application and stand ready for further action on the merits. In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues over the Cited Reference

Claims 1-5 have been rejected under the provisions of 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over **Wada et al. '582** (US 6,150,582).

Applicants respectfully traverse. Reconsideration and withdrawal of the above rejection are respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;

- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;
- (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

Distinctions Over the Cited Reference

During the interview on November 24, 2008 with the Examiner, the Examiner acknowledged that Applicants showed unexpected results with respect to the specific examples of Wada et al. ‘582 in the previously submitted Rule 132 Declaration. However, the Examiner asserted that other sections of Wada et al. ‘582 provide disclosure that is closer to the claimed invention. In response, Applicants respectfully submit that Applicants are only required to compare the present invention with the examples actually specified in Wada et al. ‘582. As such, Applicants respectfully request the Examiner to reconsider the previously submitted Rule 132 Declaration.

In addition, enclosed herewith is another 37 CFR § 1.132 Declaration of Tomoki Kawakita, one of the present inventors. The Examiner is respectfully requested to review the enclosed Declaration of Tomoki Kawakita as it provides strong evidence of the patentability of the present invention.

As shown in Table I of the enclosed Declaration, the water-absorbent resin of Wada et al. '582 cannot satisfy both the water absorption (a) limitation and the water-retaining capacity (b) limitation of claim 1.

Furthermore, Tables III and IV show that the properties of the comparative absorbent article obtained by using water-absorbent resin (B) are poorer than the properties of the absorbent article of the present invention, especially in the amount of re-wet. The results verify that the properties of the absorbent article are influenced by the properties of the water-absorbent resin used.

Therefore, the water-absorbent resin disclosed in Wada et al. '582 does not inherently have the properties of the water-absorbent resin of the present invention.

Moreover, relevant to the § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. See MPEP 716.02(b) and 716.02(e).

According to MPEP 2145, rebuttal evidence and arguments can be presented by way of a declaration under 37 CFR 1.132, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). Office personnel should consider all rebuttal arguments and evidence presented by Applicants. See, e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“[Rebuttal evidence] may relate to any of the *Graham* factors including the so-called secondary considerations.”). Rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties. *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990).

Thus, due to the unexpected results as achieved by the present invention, the obviousness rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In view of both Rule 132 Declarations, the present invention is not anticipated by Wada et al. '582 since the reference does not teach or provide for each of the limitations recited in the pending claims.

Turning back to the obviousness rejection, as stated in *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007), "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Furthermore, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* As described above, Applicants have shown that the present invention achieves unexpected and unpredictable results. Thus, due to the unexpected results as achieved by the present invention, the rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1-5 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: JUN 12 2009

Respectfully submitted,

By 

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Attachment: 37 CFR § 1.132 Declaration of Tomoki Kawakita